

REMARKS

Claims 1-34 are pending in the present application. Claims 1-8 and 26-34 are withdrawn subject to a restriction requirement. Applicant confirms this election of Group II (claims 9-25) without traverse. The Examiner rejected claims 9-25 based various statutory grounds. Specifically, the Examiner rejected claims 14, 15, and 19 under 35 U.S.C. §112, second paragraph. Further, the Examiner rejected claims 9-25 under 35 U.S.C. §103(a) as unpatentable over three combinations of references: Beltzer in combination with Miller, Tuttle in combination with Miller, and Gulla in combination with Miller.

Reconsideration of the application is respectfully requested in view of the following responsive remarks.

Specification

Per the Examiner's request, the Applicant has amended the title to increase descriptiveness thereof. Support for the amendment to the title can be found in claim 9 as filed and throughout the specification. Therefore, no new matter is introduced by this amendment.

Rejections under 35 U.S.C. §112, second paragraph

Claim 14 was rejected as confusing with respect to the claim term "underprinted." This confusion appears to result from a misunderstanding regarding the language of claim 9. Specifically, claim 9 is a method claim reciting three steps. In this case, the step of "jetting a first ink-jetable composition" and the step of "applying a second composition" are listed as distinct steps. However, the steps need not be performed sequentially and may be performed simultaneously.

With respect to claim 14, the step of "applying" need not occur when the second composition is deposited on a substrate. Rather, the step of "applying" the second composition *to the predetermined pattern* may occur as the predetermined pattern is formed by jetting the first ink-jetable composition on the substrate.

Therefore, claim 14 can be understood to mean that the second composition may be printed on the substrate prior to jetting of the first ink-jetable composition. The predetermined pattern refers to the pattern formed by the first ink-jetable composition regardless of whether the second composition is applied after or before the first ink-jetable composition. This is reinforced by the specification describing embodiments where the second composition (the reducing agent) is deposited prior to

the palladium aliphatic amine complex. See page 9, lines 9-10. In summary, the step of “applying” can be read to refer to the bringing together of the second composition and the predetermined pattern regardless of the order of applying/printing on the substrate.

Therefore, it is respectfully submitted that claim 14 clearly defines the claimed invention and the rejection thereof under 35 U.S.C. §112, second paragraph, should be withdrawn.

Claim 15 was also rejected as not further limiting claim 9. It is respectfully submitted that this assertion is in error and appears to be based on the same misunderstanding with respect to claim 14. Specifically, the second composition can be placed on the substrate either prior to, or subsequent to, the first ink-jettable composition.

Thus, the second composition can be overprinted or underprinted with respect to the first ink-jettable composition. As such, claim 15 is narrower in scope than claim 9 from which it depends for at least two reasons, namely that it requires printing and further, overprinting. Therefore, the rejection of claim 15 should be withdrawn.

Claim 19 was also rejected as not further limiting. Specifically, this claim limits the second composition to an ink-jettable composition. The Applicant notes that steps a) and b) of claim 9 intentionally use different verbs to begin each phrase, i.e. “jetting” and “applying”. As described in the specification at page 9, lines 28-31 and elsewhere, the second composition can be applied as an ink-jettable formulation *or* by other methods such as immersion, spraying, screen printing, or other printing techniques. Therefore, claim 19 is narrower in scope than claim 9 and the rejection of claim 19 should also be withdrawn.

Rejections under 35 U.S.C. §103(a)

All of claims 9-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over three different combinations of references. It is well known that each and every element of the claimed invention must be taught or suggested by the combination of references in order to present a prima facie case of obviousness. It is respectfully submitted that none of the combination of references teaches or suggests each and every element of the claimed invention as more specifically described below.

Beltzer in Combination with Miller

Claims 9-25 were rejected as obvious over Beltzer in combination with Miller. Neither Beltzer nor Miller teach or suggest the claimed “palladium aliphatic amine complex.” Beltzer teaches chemical plating of solids using various metal salts. However, Beltzer fails to teach or suggest the specifically claimed palladium aliphatic amine complexes. Miller also fails to teach or suggest such palladium complexes. Therefore, even if proper, which point we do not concede, the combination of Beltzer and Miller cannot be used to sustain a case of prima facie obviousness. Applicant respectfully requests that this rejection be withdrawn and that claims 9-25 be allowed.

Tuttle in Combination with Miller

Claims 9-25 were rejected as obvious over Tuttle in combination with Miller. Neither Tuttle nor Miller teach or suggest the claimed “palladium aliphatic amine complex.” Tuttle teaches chemical plating of plastics and other non-metallic solids using various metal salts. However, Tuttle fails to teach or suggest the specifically claimed palladium *aliphatic amine* complexes. Miller also fails to teach or suggest such palladium complexes. The Examiner’s position with respect to forming the metal complex in multiple steps is moot as such a position still does not teach or suggest a palladium *aliphatic amine* complex. Therefore, even if proper, which point we do not concede, the combination of Tuttle and Miller cannot be used to sustain a case of prima facie obviousness. Applicant respectfully requests that this rejection be withdrawn and that claims 9-25 be allowed.

Gulla in Combination with Miller

Claims 9-25 were rejected as obvious over Gulla in combination with Miller. Neither Gulla nor Miller teach or suggest the claimed “palladium aliphatic amine complex.” Gulla teaches chemical plating using various metal salts. However, Gulla fails to teach or suggest the specifically claimed palladium *aliphatic amine* complexes. Miller also fails to teach or suggest such palladium complexes. Therefore, even if proper, which point we do not concede, the combination of Gulla and Miller cannot be used to sustain a case of prima facie obviousness. Applicant respectfully requests that this rejection be withdrawn and that claims 9-25 be allowed.

CONCLUSION

In view of the foregoing, Applicants believe that claims 9-25 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone Don Coulman at (541) 715-1694 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 5 day of August, 2005.

Respectfully submitted,



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